

JAN 23 2004  
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PATENT & TRADEMARK OFFICE

JAN 30 2004

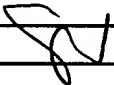
PTO/SB/21 (08-03)

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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	09/678,850	
	Filing Date	October 4, 2000	
	First Named Inventor	Joshua REITER	
	Art Unit	3629	
	Examiner Name	Edward R. COSIMANO	
Total Number of Pages in This Submission	68	Attorney Docket Number	REITE0004

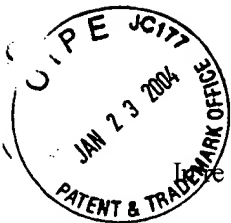
ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Exhibits; Copy of previously filed Petition
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Joerg-Uwe Szipl Registration No. 31,799 GRIFFIN & SZIPL, P.C.
Signature	
Date	January 23, 2004

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name			
Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 30 2004

OFFICE OF PETITIONS

Inventor Application of:

Joshua REITER

Serial No. 09/678,850

Filed: October 4, 2000

For: INTERACTIVE PROCESS FOR  
APPLYING OR PRINTING  
INFORMATION ON LETTERS  
OR PARCELS

) Atty. Docket: REITE0004

) Confirmation No.: 5969

)

)

) Group Art Unit: 3629

)

)

) Examiner: COSIMANO, Edward R.

)

)

) Date: January 23, 2004

)

**AMENDED PETITION PURSUANT TO 37 C.F.R. § 1.182, OR, IN THE ALTERNATIVE,  
PURSUANT TO 37 C.F.R. § 1.183, TO RECEIVE REFUND OF  
FEES PAID IN EXCESS OF THAT REQUIRED**

**MAIL STOP PETITION**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The present petition is an amended version of Applicant's "PETITION PURSUANT TO 37 C.F.R. § 1.182, OR, IN THE ALTERNATIVE, PURSUANT TO 37 C.F.R. § 1.183, TO RECEIVE REFUND OF FEES PAID IN EXCESS OF THAT REQUIRED," (hereafter, the "December 30<sup>th</sup> Petition"), filed on December 30, 2003, with regards to the above captioned application. A copy of the December 30<sup>th</sup> Petition as filed, along with a copy of the date stamped receipt, are attached. The presently amended petition adds a request for refund of additional fees paid by the Applicant when filing an Appeal Brief on January 6, 2004, which became necessary to avoid abandonment while the United States Patent and Trademark Office (USPTO) performs its "second pair of eyes" review of the present application.

Because Applicant previously paid the petition fee when filing the December 30<sup>th</sup> Petition, no further fees are believed to be required with the filing of the presently amended version of the December 30<sup>th</sup> Petition.

In accordance with 35 U.S.C. § 42, the Director “may refund...any amount paid in excess of that required.” For the following reasons, Applicant respectfully requests a refund of the following fees paid by him that the Applicant believes was paid in excess of that required: (1) \$475.00 for three month extension of time, (2) \$165.00 for Notice of Appeal, and (3) \$165.00 for filing an Appeal Brief. Applicant believes that these fees, totaling \$805.00, were paid in excess of that required as explained below.

#### **The Factual Situation**

In the above captioned application, Applicant received a non-final Office Action dated December 31, 2002, which rejected claims 1-50 under the judicially created doctrine of obviousness-type double patenting over either (a) claims 1-20 of U.S. Patent 5,819,241, or (b) claims 1-35 of U.S. Patent 6,178,411. In response to the December 31<sup>st</sup> Office Action, Applicant filed two terminal disclaimers on February 11, 2003 (See Exhibit A, Response (C), two terminal disclaimers and filing receipt). Subsequently, Applicant received a Final Office Action dated May 6, 2003, which rejected claims 1-50 under the judicially created doctrine of obviousness-type double patenting over claims 1-20 of U.S. Patent 5,819,241. In response to the Final Office Action, Applicant re-filed the terminal disclaimer directed to U.S. Patent 5,819,241 along with Response (D) After Final on May 20, 2003 (see Exhibit B, Response (D), one terminal disclaimer and filing receipt). On June 2, 2003, Examiner Cosimano allowed all of the claims as indicated by the Patent Application Information Retrieval System (see Exhibit C). However, the United States Patent and

Trademark Office (“USPTO”), however, a Notice of Allowability was never sent. Instead, Applicant’s allowed application was sent for a “second pair of eyes” review. The case presently sits awaiting further action. In the meantime, the USPTO has imposed fees against the Applicant while his Application undergoes this “second pair of eyes” review (see Exhibit D).

#### **Improper Finality of the May 6 Office Action**

The finality of the May 6 Office Action is improper and should be withdrawn in accordance with MPEP § 706.07(d). Specifically, Applicant properly responded to the Examiner’s December 31 Office Action by filing two terminal disclaimers, including a terminal disclaimer directed to U.S. Patent 5,819,241. Therefore, the present application should have been allowed and sent for a second pair of eyes review while the application was in a non-final status.

However, a clerical error at the USPTO resulted in the separation of the terminal disclaimer filed February 11, 2003, and directed to U.S. Patent 5,819,241 from the rest of the papers filed by the Applicant on that day. Because of this clerical error at the USPTO, both properly filed terminal disclaimers did not reach the application and the Examiner issued the May 6 Final Office Action. The claims of the present application were subsequently allowed by Examiner Cosimano on June 2, 2003, after Applicant filed Response (D) After Final on May 20, 2003, which included a copy of Applicant’s Response (C) and the terminal disclaimer directed to U.S. Patent 5,819,241.

Therefore, the application was in an improper “after final” status when the claims were allowed by Examiner Cosimano on June 2, 2003. Specifically, it was a clerical error on the part of the USPTO that resulted in the separation of one of the two properly filed terminal disclaimers. This clerical error resulted in the finality of the May 6 Office Action. This finality determination is invalid on technical grounds because the Examiner failed to consider a properly filed terminal

disclaimer. Thus, the premature finality as a matter of fact and cannot be viewed as a discretionary matter. Subsequently, the USPTO imposed fees for extensions of time against the Applicant. In this case, the fees are in excess of what is required because the Applicant should not have to pay for time when the "after final" status of an application is improper and the application contains only allowed claims.

In Ex parte Grady, 59 USPQ 276 (Comm'r Pat. 1943), the USPTO declined to refund an administrative fee for statutory extensions of time paid by the applicant even though the Examiner subsequently withdrew finality and allowed all of the claims. In that case, the Commissioner decided that "the error committed in rejecting allowable claims...is not the type of neglect" to warrant a refund. However, Grady is distinguishable from the present circumstances for several reasons.

In Grady the Examiner withdrew his final rejection and allowed the claims as a matter of discretion. The Applicant in Grady paid to maintain pendency of the application while the Examiner reconsidered it. In the present case, the "finality" of the rejection was premature and should have been withdrawn for several reasons. First, the "finality" of the May 6 rejection was technically flawed. Had Applicant's two terminal disclaimers, filed February 11, 2003, been properly matched with the file, the Examiner would have considered both disclaimers and allowed Applicant's claims rather than issue the May 6 Final Office Action. Second, Applicant's claims have been allowed pending a "second pair of eyes" review. There is no rational reason why Applicant should have to pay to maintain the pendency of his application once the claims have been allowed. It is Applicant's understanding that if the allowed claims withstood the "second pair of eyes" review, the USPTO would send Applicant his Notice of Allowability. Yet, even if the allowed claims were subsequently rejected as a result of the "second pair of eyes" review, the

finality would be withdrawn, and a new office action issued. Such procedure is common at the USPTO. Commonly, when the Examiner allows the claims, a Notice of Allowability is issued, and, if the Examiner then finds additional prior art that necessitates withdrawing the Notice of Allowability, a non-final Office Action would be issued. In such cases, the USPTO does not impose additional fees on the Applicant to maintain pendency of his application.

Because the present circumstances are analogous to a situation in which the USPTO withdraws allowability of allowed claims than the erroneous rejection of allowable claims in Grady, the USPTO should refund Applicant's fees paid to maintain pendency of his allowed claims.

**Administrative Alternative: Ex parte Quayle Procedure**

The USPTO should refund the requested fees because there are alternative procedures at the USPTO for handling applications once the claims have been allowed, and these procedures remove the conditions imposed by the obviously improper final rejection in the present case. Specifically, in Ex parte Quayle, 25 USPQ 74 (Comm'r Pat. 1935), the Commissioner held that once the claims are allowed and only formal matters remain, the Examiner may close prosecution of the application. In such cases, the applicant is given an opportunity to make amendments limited to those required to place the application in condition for allowance. In accordance with MPEP § 706.07(f)(N), (see Exhibit E), when an application is after final and an amendment places all of the claims in condition for allowance except for formal matters, the Examiner should issue an Ex parte Quayle action. When this occurs, "[n]o extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters—the correction of which had now yet been required by the Examiner." MPEP § 706.07(f)(N). Thus, the allowability of the claims in Ex parte Quayle practice removes the finality of the Final Office Action.

In the present case, by analogy with Ex parte Quayle procedures, when Examiner Cosimano determined the allowability of the claims of the present application, this decision should have triggered the automatic removal of finality. It should make no difference whether the allowed claims await correction of formal matters or further review by the USPTO. Once the claims have been allowed, as under Ex parte Quayle proceedings, finality should be withdrawn. Therefore, the fees paid by the Applicant to maintain pendency of his application are in excess of those required and should be refunded.

**Administrative Alternative: Suspension of Action by USPTO**

The USPTO should refund the requested fees because there are alternative procedures at the USPTO for suspending action on an application in accordance with 37 C.F.R. § 1.103 (e). Specifically, 37 C.F.R. § 1.103 (e) establishes that the USPTO may suspend action on its own initiative. When the USPTO does so, it should notify the applicant. MPEP § 709 describes the scenario where the USPTO might choose to suspend action on an application while waiting for the availability of a reference (Exhibit F, MPEP pp. 700-126 and 700-131).

In the present case, once Examiner Cosimano decided that Applicant's claims were allowed, the USPTO should have issued a Notice of Allowability in accordance with MPEP § 1302.03. When delays in processing a Notice of Allowability are expected, the Examiner "should notify applicant by way of an interview....Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment." MPEP § 1302.03. However, the USPTO improperly did not issue a Notice of Allowability, and the Examiner did not notify applicant by way of an interview as required. Instead, the USPTO chose to suspend this action while awaiting the availability of a "second pair of eyes" review. In other

words, the USPTO performed a de facto suspension of action in accordance with 37 C.F.R. § 1.103.

Furthermore, the USPTO did not notify Applicant that his Notice of Allowability was being suspended pending the “second pair of eyes” review. Applicant asserts that when the USPTO initiates a suspension of action, either formally or de facto, it is improper to impose fees against the Applicant to maintain pendency of his allowed claims. For this reason, the fees paid by Applicant to maintain pendency of his application are in excess of those required and should be refunded.

### **Conclusion**

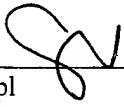
The fees requested for refund should be refunded to the Applicant because these fees were in excess of those required. Specifically, Applicant should not have to pay to maintain pendency of his allowed claims for three reasons. First, the Final Office Action was premature as a matter of fact, and not as a result of the Examiner’s discretion. Second, the determination that all claims are allowable automatically removes finality in other USPTO procedures, as under Ex parte Quayle. Third, the decision by the USPTO to withhold Applicant’s Notice of Allowability while awaiting a “second pair of eyes” review amounted to a de facto suspension of action initiated by the USPTO under 37 C.F.R. § 1.103. Consequently, it would be unfair for the USPTO to charge fees to the Applicant to maintain pendency of his allowed claims when the USPTO takes the initiative to suspend action on his application.



Questions are welcomed by the below-signed attorney for Applicant. The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment or refund to Deposit Account No. 501281.

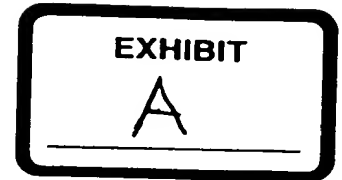
Respectfully submitted,

GRIFFIN & SZIPL, PC

  
\_\_\_\_\_  
Joerg-Uwe Szipl  
Reg. No. 31,799

GRIFFIN & SZIPL, PC  
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Facsimile: (703) 979-7429  
Customer No.: 24203



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 30 2004

OFFICE OF PETITIONS

In re Application of:

Joshua REITER

Serial No. 09/678,850

Filed: October 4, 2000

For: INTERACTIVE PROCESS FOR  
APPLYING OR PRINTING  
INFORMATION ON LETTERS  
OR PARCELS

)  
) Atty. Docket: REITE0004  
)  
)  
) Group Art Unit: 3629  
)  
)  
) Examiner: COSIMANO, Edward. R.  
)  
)  
) Date: February 11, 2003  
)

RESPONSE (C)

BOX: NO FEE AMENDMENT  
Assistant Commissioner of Patents  
Washington, D. C. 20231

Sir:

In response to the Office Action dated December 31, 2002, with respect to the above-captioned application, please consider the following remarks.

REMARKS

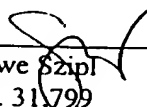
Applicant files herewith timely revised terminal disclaimers in compliance with 37 C.F.R. 1.321(c), one disclaimer each to United States Patent 5,819,241 and 6,178,411 B1. Applicant points out that the fee for the terminal disclaimer was paid previously, although the Examiner deemed the previous terminal disclaimer filed October 7, 2002, as being defective (Office Action dated December 31, 2002, page 3, lines 6-21). By timely filing the terminal disclaimers in the present application, Applicant has mooted the nonstatutory double patenting rejection of claims 1-50, based on a judicially created doctrine of obviousness-type double patenting, over either claims 1-20 of U.S. Patent 5,819,241 or claims 1-35 of U.S.

Patent 6,178,411.

For all of the reasons above, claims 1-50 are in condition for allowance and a prompt notice of allowance is earnestly solicited. Questions are welcomed by the below-signed attorney for applicant. The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 501281.

Respectfully submitted,

GRIFFIN & SZIPL, PC

  
\_\_\_\_\_  
Joerg-Uwe Szimpl  
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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)  
REITE0004

In re Application of: Joshua REITER

Application No.: 09/678,850

Filed: October 4, 2000

For: INTERACTIVE PROCESS FOR APPLYING OR PRINTING INFORMATION ON LETTERS OR PARCELS

The owner\*, Joshua J. Reiter of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,819,241. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record

  
Signature

02/11/2003

Date

Joerg-Uwe Szpil, Registration No. 31,799

Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner) Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

U.S. PATENT & TRADEMARK OFFICE  
JAN 23 2004

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

REITE0004

Re Application of: Joshua REITER

Application No.: 09/678,850

Filed: October 4, 2000

For: INTERACTIVE PROCESS FOR APPLYING OR PRINTING INFORMATION ON LETTERS OR PARCELS

The owner\*, Joshua J. Reiter of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,178,411 B1. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

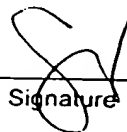
In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

  
Signature

02/11/2003

Date

Joerg-Uwe Szipl, Registration No. 31,799

Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner) Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

r 4.  
This card, when stamped with the date stamp of the U. S. Patent and Trademark Office, acknowledges receipt of the following papers relating to application Serial No. 09/678,850 of Joshua J. REITER filed October 4, 2000:

1. Response (C);
2. Terminal Disclaimer for U.S. Patent 5,819,241; and
3. Terminal Disclaimer for U.S. Patent 6,178,411 B1.

Dkt. #REITE0004

Due: 3-31-2003 (JUS/ldh)

Joshua J. REITER





EXHIBIT

B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Joshua REITER ) Atty. Docket: REITE0004  
Serial No. 09/678,850 ) Group Art Unit: 3629  
Filed: October 4, 2000 ) Examiner: COSIMANO, Edward. R.  
For: INTERACTIVE PROCESS FOR )  
APPLYING OR PRINTING )  
INFORMATION ON LETTERS ) Date: May 20, 2003  
OR PARCELS )

RESPONSE (D) AFTER FINAL

BOX: NO FEE AMENDMENT  
Assistant Commissioner of Patents  
Washington, D. C. 20231

Sir:

In response to the final Office Action dated May 6, 2003, with respect to the above-captioned application, please consider the following remarks.


REMARKS

Applicant filed, on February 11, 2003, a timely terminal disclaimer in compliance with 37 C.F.R. 1.321(c) to United States Patent 5,819,241 as shown by the attached copy of the terminal disclaimer and the copy of the receipt card, dated February 11, 2003. However, this terminal disclaimer appears to have been separated from the file. In view of the already-filed terminal disclaimer in the present application, Applicant has mooted the nonstatutory double patenting rejection of claims 1-50, based on the judicially created doctrine of obviousness-type double patenting over claims 1-20 of U.S. Patent 5,819,241.

For all of the reasons above, claims 1-50 are in condition for allowance and a prompt notice of allowance is earnestly solicited. Questions are welcomed by the below-signed attorney for Applicant. The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 501281. .

Respectfully submitted,

GRIFFIN & SZIPL, PC

  
\_\_\_\_\_  
Joerg-Uwe Skipl  
Reg. No. 31,799

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2300 Ninth Street, South  
Arlington, VA 22204

Telephone: (703) 979-5700  
Facsimile: (703) 979-7429  
Customer No.: 24203



This card, when stamped with the date stamp of the U. S. Patent and Trademark Office, acknowledges receipt of the following papers relating to application Serial No. 09/678,850 of Joshua J. REITER filed October 4, 2000:

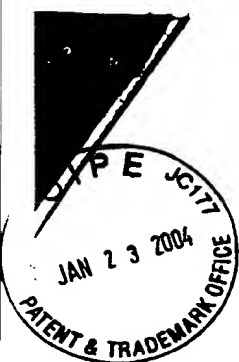
1. Response (C);
2. Terminal Disclaimer for U.S. Patent 5,819,241; and
3. Terminal Disclaimer for U.S. Patent 6,178,411 B1.

Dkt. # REITE0004

Due: 3-31-2003 (JUS/ldh)

Joshua J. REITER





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Joshua REITER

Serial No. 09/678,850

Filed: October 4, 2000

For: INTERACTIVE PROCESS FOR  
APPLYING OR PRINTING  
INFORMATION ON LETTERS  
OR PARCELS

)  
) Atty. Docket: REITE0004  
)  
)  
) Group Art Unit: 3629  
)  
)  
) Examiner: COSIMANO, Edward. R.  
)  
)  
) Date: February 11, 2003  
)

RESPONSE (C)

BOX: NO FEE AMENDMENT  
Assistant Commissioner of Patents  
Washington, D. C. 20231

Sir:

In response to the Office Action dated December 31, 2002, with respect to the above-captioned application, please consider the following remarks.

REMARKS

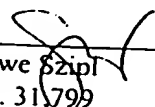
Applicant files herewith timely revised terminal disclaimers in compliance with 37 C.F.R. 1.321(c), one disclaimer each to United States Patent 5,819,241 and 6,178,411 B1. Applicant points out that the fee for the terminal disclaimer was paid previously, although the Examiner deemed the previous terminal disclaimer filed October 7, 2002, as being defective (Office Action dated December 31, 2002, page 3, lines 6-21). By timely filing the terminal disclaimers in the present application, Applicant has mooted the nonstatutory double patenting rejection of claims 1-50, based on a judicially created doctrine of obviousness-type double patenting, over either claims 1-20 of U.S. Patent 5,819,241 or claims 1-35 of U.S.

Patent 6,178,411.

For all of the reasons above, claims 1-50 are in condition for allowance and a prompt notice of allowance is earnestly solicited. Questions are welcomed by the below-signed attorney for applicant. The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 501281.

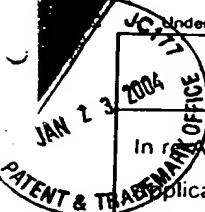
Respectfully submitted,

GRIFFIN & SZIPL, PC

  
Joerg-Uwe Szimpl  
Reg. No. 31,799

GRIFFIN & SZIPL, PC  
Suite PH-1  
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Customer No.: 24203



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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

REITE0004

In re Application of: Joshua REITER

Application No.: 09/678,850

Filed: October 4, 2000

For: INTERACTIVE PROCESS FOR APPLYING OR PRINTING INFORMATION ON LETTERS OR PARCELS

The owner\*, Joshua J. Reiter, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,819,241. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.


In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record

  
Signature

02 11 2003

Date

Joerg-Uwe Szipl, Registration No. 31,799

Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent, Arlington, Washington, DC 20503.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

REITE0004

Inventor Application of: Joshua REITER

Application No.: 09/678,850

Filed: October 4, 2000

For: INTERACTIVE PROCESS FOR APPLYING OR PRINTING INFORMATION ON LETTERS OR PARCELS

The owner\*, Joshua J. Reiter of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,178,411 B1. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record

Signature

02/11/2003

Date

Jocrg-Uwe Szipl, Registration No. 31,799

Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner) Form PTO/SB/96 may be used for making this certification. See MPEP § 324

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

HAND-CARRY TO EX. EDWARD R. COSIMANO,  
CP5 (2451 CRYSTAL DR.), 7TH FLOOR

09/678,850 of Joshua J. REITER filed October 4, 2000:  
This card, when stamped with the date stamp of the U. S. Patent and Trademark  
Office, acknowledges receipt of the following papers relating to application Serial No.

1. Response (D) After Final with copy of the Terminal Disclaimer  
and the copy of the receipt card dated February 11, 2003.

RECEIVED  
TECHNOLOGY CENTER 3500  
20 11:31

Dkt. #REITE0004 Due: 08-06-2003 (JUS/ldh) Joshua J. REITER

**EXHIBIT****C****PATENT APPLICATION INFORMATION RETRIEVAL****PAIR****FAQ****Help****Feedback****Other Links****E-Business  
Center Patents****Employee  
Locator****Class/Subclass  
GAU Information****Information  
Contacts****Search results for application number:09/678,850**

Application Number:	09/678,850	Customer Number:	24203
Filing or 371(c) Date:	10-04-2000	Status:	Allowance Counted
Application Type:	Utility	Status Date:	06-02-2003
Examiner Name:	COSIMANO, EDWARD R	Location:	TC 3600 SPRE, PK5-7A13, 305-9780
Group Art Unit:	3629	Location Date:	11-07-2003
Confirmation Number:	5969	Earliest Publication No:	-
Attorney Docket Number:	REITE0004	Earliest Publication Date:	-
Class/ Sub-Class:	705/408	Patent Number:	-
First Named Inventor:	Joshua Reiter, Baltimore, MD	Issue Date of Patent:	-
Title Of Invention:	Interactive process for applying or printing information on letters or parcels		

**Foreign Priority****Continuity Data****Publication Review****File Contents History**

Number	Date	Contents Description
36	06-02-2003	Notice of Allowability
35	05-29-2003	Notification of Terminal Disclaimer - Accepted
34	02-11-2003	Terminal Disclaimer Filed
33	05-24-2003	Date Forwarded to Examiner
32	05-20-2003	Amendment after Final Rejection
31	05-06-2003	Mail Notification of Terminal Disclaimer - Accepted
30	05-06-2003	Mail Final Rejection (PTOL - 326)
29	05-05-2003	Final Rejection
28	02-27-2003	Notification of Terminal Disclaimer - Accepted
27	02-11-2003	Terminal Disclaimer Filed
26	02-11-2003	Terminal Disclaimer Filed
25	02-25-2003	Date Forwarded to Examiner
24	02-11-2003	Response after Non-Final Action
22	12-31-2002	Mail Notification of Terminal Disclaimer - Not Accepted
21	12-31-2002	Mail Non-Final Rejection
20	12-30-2002	Non-Final Rejection
19	12-17-2002	Notification of Terminal Disclaimer - Not Accepted
18	10-07-2002	Terminal Disclaimer Filed
17	10-07-2002	Terminal Disclaimer Filed
16	10-16-2002	Date Forwarded to Examiner
15	10-07-2002	Response after Non-Final Action
14	08-21-2002	Mail Non-Final Rejection
13	08-20-2002	Non-Final Rejection
12	04-23-2002	Case Docketed to Examiner in GAU
11	04-23-2002	Case Docketed to Examiner in GAU
10	04-23-2002	Case Docketed to Examiner in GAU
9	12-06-2001	Case Docketed to Examiner in GAU
8	11-30-2000	Information Disclosure Statement (IDS) Filed
7	10-04-2000	Information Disclosure Statement (IDS) Filed

6	10-04-2000	Preliminary Amendment
5	04-22-2001	Case Docketed to Examiner in GAU
4	11-20-2000	Application Dispatched from OIPE
3	11-14-2000	Correspondence Address Change
2	11-01-2000	IFW Scan & PACR Auto Security Review
1	10-04-2000	Initial Exam Team nn

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D

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MATTERS

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E-MAIL: SZIPL@SZIPL.COM  
WEB SITE: WWW.SZIPL.COM

November 18, 2003

Joshua J. Reiter, Ed. D.  
500 West University Parkway # 12 T  
Baltimore, MD 21210

Re: U.S. Patent Application Serial No. 09/678,850  
entitled "Interactive Process for Applying or  
Printing Information on Letters or Parcels"  
Inventor: Joshua J. Reiter  
Our Ref.: REITE0004

Dear Josh:

In accordance with your telephone instructions to me regarding the above-captioned application, we filed a Notice of Appeal on November 6, 2003. A copy of the Notice of Appeal as filed is enclosed for your records.

We share your concerns regarding this case and summarize the status of this application as follows. As we informed you in our letter dated May 20, 2003, the outstanding Office Action dated May 6, 2003, is a Final Office Action and we responded to this action on May 20, 2003. We attach another copy of our May 20<sup>th</sup> letter for your convenience. Because the last Action is a Final Office Action, the time period to respond continues to run until the application is allowed, an appeal is made, the case goes abandoned, or the Examiner decides to reopen prosecution.

On August 4, 2003, we contacted Examiner Cosimano because we had not received a reply from the Patent Office. Examiner Cosimano informed us that the application had been "allowed," but because it dealt with a business method the application had been referred to another examiner for a "second pair of eyes review" (See USPTO PAIRs report and a copy of Dr. Ashton's memo, both attached herewith). Examiner Cosimano informed us at that time that the application had been referred to another examiner for "second pair of eyes" review. The result of this secondary review would be either (1) allowance of the application, or (2) issuance of a new non-final rejection.

The "second pair of eyes" review procedure is a new procedure at the Patent Office and this is the first case in which we have had to deal with it. Apparently, because the procedure is new, unfair delays in application processing are occurring at the Patent Office. Examiner Cosimano informed us that the "second pair of eyes" review could take up to six months.

We are concerned about the unfair delay in the prosecution of your patent application so we continued our inquiry. We are particularly interested in knowing if you are entitled to a refund of any money you have to spend paying for the delays at the Patent Office. So, we first contacted the Office of Petitions and spoke with Wan Leyman, a Patent Examiner detailed to this office. Ms. Leyman was unaware of the "second pair of eyes" review program and was unable to address any of our questions.

Next, we contacted Stephen Kunnin's Office, the Deputy Commissioner for Patent Examination Policy (703-305-8850) and spoke to Karen Ferriter, a member of Mr. Kunnin's Staff. Ms. Ferriter was knowledgeable about the "second pair of eyes" review program. She informed us that our options are limited while the patent application is undergoing review. We explained that your application was an after final application and that you were being unfairly subjected to additional fees in order to prevent your patent application from going abandoned as a result of the delays caused by the Patent Office.

Ms. Ferriter agreed that it was inequitable for you to have to pay these fees as a result of delays at the Patent Office. However, Ms. Ferriter could only recommend paying the fees; otherwise, your application would go abandoned. Ms. Ferriter said we could petition to get a refund for fees paid to keep the application alive while the Patent Office performed its "second pair of eyes" review. Ms. Ferriter could not guarantee the Patent Office would grant such a petition and refund those fees.

We discussed with Ms. Ferriter your need to file a Notice of Appeal to keep your application from going abandoned. Ms. Ferriter stated that when it is necessary to file such an appeal, we should to keep the application alive. We discussed with Ms. Ferriter the possibility that an appeal brief could come due before the "second pair of eyes" review was completed. Ms. Ferriter told us that we might have to file an appeal brief, if necessary, to keep your case alive if the "second pair of eyes" review was not completed before the appeal brief is due. This would be an onerous burden on you to have to pay for an appeal brief when your application has been provisionally allowed.

We are very concerned about the cavalier position of the Patent Office with respect to the additional costs the "second-pair of eyes" review may impose upon you. We expressed our grave concern on your behalf and the degree of unfairness the secondary review program is creating. Ms. Ferriter was kind enough to give us the name and phone number of the "second pair of eyes" reviewing examiner (Mr. Robert Weinhardt, 703-305-9780) and the Group Director, Mr. John Love (703-308-1020), responsible for the "second pair of eyes" review. We tried to contact these individuals on November 6, 2003 and were unsuccessful.

Consequently, we filed your Notice of Appeal on November 6, 2003. On November 7, 2003, Examiner Weinhardt called us and informed us that he had completed the "second pair of eyes" review, and was forwarding your application back to Examiner Cosimano. Examiner Weinhardt told us that he recommended further consideration of prior art he found during his research. Examiner Weinhardt explained that any references he considered relevant would be considered by Examiner Cosimano and his supervisor.


On November 10, 2003, Supervisory Patent Examiner John Weiss contacted us and informed us that new prior art had been uncovered by the "second pair of eyes" review. Mr. Weiss is the supervisor of Examiner Cosimano. Mr. Weiss told us that a new, non-final Office Action would be issued in the near future.

We hope our summary of events helps clarify the issues faced at the Patent Office. We have done our best to advocate interests, and we believe we have been successful at getting your application through the "second pair of eyes" review. We plan to petition the Patent Office for a refund of the fees imposed upon you as a result of delays at the Patent Office. We will, of course, keep you advised of all developments in this matter. In the meantime, however, if you have any questions in this regard, please let us know.

Best regards.

Very truly yours,

GRIFFIN & SZIPL, P.C.

---

Joerg-Uwe Szipl

JUS/WSA/cjf  
Enclosure

MEMO TO FILE:

Date: August 4, 2003

Examiner Cosimano called me back regarding the REITE0004 patent application (U.S. Patent Application No. 09/678,850). The Examiner indicated that the Terminal Disclaimers have been considered and that the case was allowed June 2, 2003. However, because the case deals with a method of doing business, the case has been forwarded to another examiner for a "second pair of eyes" review. If the second examiner agrees with the allowance, the USPTO will mail a Notice of Allowance. If the second examiner does not agree with the allowance, then a non-final office action will be issued.

W. Scott Ashton

WSA

the case of reexamination, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved.

The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

New grounds of rejection made in an Office action reopening prosecution after the filing of an appeal brief require the approval of the supervisory patent examiner. See MPEP § 1002.02(d).

### 706.07(f) Time for Reply to Final Rejection [R-1]

The time for reply to a final rejection is as follows:

(A) All final rejections setting a 3-month shortened statutory period (SSP) for reply should contain one of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.41.03, or 7.42.09 advising applicant that if the reply is filed within 2 months of the date of the final Office action, the shortened statutory period will expire at 3 months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable reply period will be established. > If the last day of "2 months of the date of the final Office action" falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, and a reply is filed on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday, pursuant to 37 CFR 1.7(a), the reply is deemed to have been filed within the 2 months period and the shortened statutory period will expire at 3 months from the date of the final rejection or on the mailing date of the advisory action, whichever is later (see MPEP § 710.05). < In no event can

the statutory period for reply expire later than 6 months from the date of the final rejection.

(B) If the form paragraph setting a variable reply period is inadvertently not included in the final Office action, the SSP for reply will end 3 months from the date of the final Office action and cannot be extended other than by making a petition and paying a fee pursuant to 37 CFR 1.136(a). However, if an advisory action is mailed in such a case where the reply to the final action has been filed within 2 months, the examiner should vacate the original SSP and reset the period for reply to correspond with the Office policy set forth in the Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," 1027 O.G. 71 (Feb. 8, 1983). See paragraph (F) below.

(C) This procedure of setting a variable reply period in the final rejection dependent on when applicant files a first reply to a final Office action does not apply to situations where a SSP less than 3 months is set, e.g., reissue litigation applications (1-month SSP) or any reexamination proceeding.

### ADVISORY ACTIONS

(D) Where the final Office action sets a variable reply period as set forth in paragraph (A) above AND applicant files a complete first reply to the final Office action within 2 months of the date of the final Office action, the examiner must determine if the reply:

(1) places the application in condition for allowance — then the application should be processed as an allowance and no extension fees are due;

(2) places the application in condition for allowance except for matters of form which the examiner can change without authorization from applicant, MPEP § 1302.04 — then the application should be amended as required and processed as an allowance and no extension fees are due; or

(3) does not place the application in condition for allowance — then the advisory action should inform applicant that the SSP for reply expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later, by checking the appropriate box at the top portion of the Advisory Action form, PTOL-303.

If PTOL-303 is not used, then use Form Paragraph 7.67.01 on all advisory actions where a first complete reply has been filed within 2 months of the date of the final Office action.

## EXAMINATION OF APPLICATIONS

706.07(f)

### § 7.67.01 *Advisory After Final, Heading, 1st Reply Filed Within 2 Months*

The shortened statutory period for reply expires **THREE MONTHS** from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

#### **Examiner Note:**

1. This form paragraph should be used in all advisory actions if:
  - a. it was the **FIRST** reply to the to the final rejection, and
  - b. it was filed within two months of the date of the final rejection.
2. If a notice of appeal has been filed, also use form paragraph 7.68.
3. **DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.**
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

(E) Where the final Office action sets a variable reply period as set forth in paragraph (A) above, and applicant does **NOT** file a complete first reply to the final Office action within 2 months, examiners should use form paragraph 7.67.

(F) Where the final Office action does not set a variable reply period as set forth in paragraph (A) above **AND** applicant does file a complete first reply to the final Office action within 2 months, and if an advisory action is necessary and cannot be mailed within 3 months of the final Office action, the examiner should vacate the original SSP and reset the reply period to expire on the mailing date of the advisory action by using form paragraph 7.67.02. In no case can the statutory period for reply expire later than 6 months from the date of the final Office action. Note that form paragraph 7.67.02 can be used with the advisory action (preferable) or after the advisory action is mailed to correct the error of not setting a variable reply period.

### § 7.67.02 *Advisory After Final, Heading, No Variable SSP Set in Final*

Since the first reply to the final Office action was filed within **TWO MONTHS** of the mailing date of that action and the advisory action was not mailed within **THREE MONTHS** of that date, the **THREE-MONTH** shortened statutory period for reply set in the final Office action is hereby vacated and reset to expire as of the mailing date of this advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," published in the *Official Gazette* at 1027 O.G. 71, February 8, 1983.

In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of the final Office action.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

#### **Examiner Note:**

1. This form paragraph should be used in all advisory actions where:
  - a. the reply is a first reply to the final action;
  - b. the reply was filed within two months of the mailing date of the final; and
  - c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraphs 7.39 to 7.41.
2. If the final action set a variable SSP, do not use this form paragraph, use form paragraph 7.67.01 instead.
3. If a notice of appeal has been filed, also use form paragraph 7.68.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

(G) When an advisory action properly contains either form paragraph 7.67.01 or 7.67.02, the time for applicant to take further action (including the calculation of extension fees under 37 CFR 1.136(a)) begins to run 3 months from the date of the final rejection, or from the date of the advisory action, whichever is later. Extension fees cannot be prorated for portions of a month. In no event can the statutory period for reply expire later than 6 months from the date of the final rejection. For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such case, if a petition for extension of time is granted, the due date for a reply is computed from the date stamped or printed on the Office action with the final rejection. See MPEP § 710.01(a). If the examiner, however, does not mail an advisory action until after the end of the 3-month period, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension of time fee would be calculated from the mailing date of the advisory action.

## EXAMINER'S AMENDMENTS

(H) Where a complete first reply to a final Office action has been filed within 2 months of the final Office action, an examiner's amendment to place the

application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action. Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.

(I) Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant's authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a). However, an examiner's amendment correcting only formal matters which are identified for the first time after a reply is made to a final Office action would not require any extension fee, since the reply to the final Office action put the application in condition for allowance except for the correction of formal matters, the correction of which had not yet been required by the examiner.

(J) An extension of time under 37 CFR 1.136(a) requires a petition for an extension and the appropriate fee provided for in 37 CFR 1.17. Where an extension of time is necessary to place an application in condition for allowance (e.g., when an examiner's amendment is necessary after the shortened statutory period for reply has expired), applicant may file the required petition and fee or give authorization to the examiner to make the petition of record and charge a specified fee to a deposit account. Office employees may not accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process or trademark process fee (as opposed to information product or service fees) to a credit card. When authorization to make a petition for an extension of time of record is given to the examiner, the authorization must be given before the extended period expires. The authorization must be made of record in an examiner's amendment by indicating the name of the person making the authorization, when the authorization was given, the deposit account number to be charged, the length of the extension requested and the amount of the fee to be charged

to the deposit account. Form Paragraph 13.02.02 should be used.

#### § 13.02.02 Extension of Time and Examiner's Amendment Authorized by Telephone

An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on [1], [2] requested an extension of time for [3] MONTH(S) and authorized the Commissioner to charge Deposit Account No. [4] the required fee of \$ [5] for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

#### Examiner Note:

See MPEP § 706.07(f), item (J) which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

#### PRACTICE AFTER FINAL

(K) Replies after final should be processed and considered promptly by all Office personnel.

(L) Replies after final should not be considered by the examiner unless they are filed within the SSP or are accompanied by a petition for an extension of time and the appropriate fee (37 CFR 1.17 and 37 CFR 1.136(a)). See also MPEP § 710.02(e). This requirement also applies to supplemental replies filed after the first reply.

(M) Interviews may be conducted after the expiration of the shortened statutory period for reply to a final Office action but within the 6-month statutory period for reply *without* the payment of an extension fee.

(N) Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an *Ex parte Quayle* action if the application is otherwise in condition for allowance. No extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters — the correction of which had not yet been required by the examiner.

(O) If prosecution is to be reopened after a final Office action has been replied to, the finality of the previous Office action should be withdrawn to avoid the issue of abandonment and the payment of extension fees. For example, if a new reference comes to

the attention of the examiner which renders unpatentable a claim indicated to be allowable, the Office action should begin with a statement to the effect: "The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below." Form paragraph 7.42 could be used in addition to this statement. See MPEP § 706.07(d).

### 706.07(g) Transitional After-Final Practice

*37 CFR 1.129. Transitional procedures for limited examination after final rejection and restriction practice.*

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the writ-

ten description, claims or drawings and a new substantive argument or new evidence in support of patentability.

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(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

In order to facilitate the completion of prosecution of applications pending in the USPTO as of June 8, 1995 and to ease the transition between a 17-year patent term and a 20-year patent term, Public Law 103-465 provided for the further limited reexamination of an application pending for 2 years or longer as of June 8, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121, or 365(c). The further limited reexamination permits applicants to present for consideration, as a matter of right upon payment of a fee, a submission after a final rejection has been issued on an application. An applicant will be able to take advantage of this provision on two separate occasions provided the submission and fee are presented prior to the filing of the Appeal Brief and prior to abandonment of the application. This will have the effect of enabling an applicant to essentially reopen prosecution of the pending application on two separate occasions by paying a fee for each occasion, and avoid the impact of refiling the application to obtain consideration of additional claims and/or information relative to the claimed subject matter. The transitional after-final practice is only available to applications filed on or before June 8, 1995 and it is not available for reissue or design applications or reexamination proceedings.

The following flowchart illustrates the transitional after-final procedures set forth in 37 CFR 1.129(a).



**HANDLING OF PETITIONS TO MAKE SPECIAL**

Applications which have been made special will be advanced out of turn for examination and will continue to be treated as special throughout the entire prosecution in the Office.

Each petition to make special, regardless of the ground upon which the petition is based and the nature of the decision, is made of record in the application file, together with the decision thereon. The part of the Office that rules on a petition is responsible for properly entering that petition and the resulting decision in the file record. The petition, with any attached papers and supporting affidavits, will be given a single paper number and so entered in the "Contents" of the file. The decision will be accorded a separate paper number and similarly entered. To ensure entries in the "Contents" in proper order, the technical support staff in the TC will make certain that all papers prior to a petition have been entered and/or listed in the application file before forwarding it for consideration of the petition. Note MPEP § 1002.02 (s).

Petitions to make special are decided by the Special Program Examiner of the TC to which the application is assigned.

**708.03 Examiner Tenders Resignation**

Whenever an examiner tenders his or her resignation, the supervisory patent examiner should see that the remaining time as far as possible is used in winding up the old complicated cases or those with involved records and getting as many of his or her amended cases as possible ready for final disposition.

If the examiner has considerable experience in his or her particular art, it is also advantageous to the Office if he or she indicates (in pencil) in the file wrappers of application in his or her docket, the field of search or other pertinent data that he or she considers appropriate.

**709 Suspension of Action [R-1]****37.CFR.1.103.—Suspension of action by the Office:**

(a) *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph

must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

(2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

(b) *Limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d).* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph in a continued prosecution application filed under § 1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application filed under § 1.53(d), specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(c) *Limited suspension of action after a request for continued application (RCE) under § 1.114.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(d) *Deferral of examination.* On request of the applicant, the Office may grant a deferral of examination under the conditions specified in this paragraph for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under title 35, United States Code. A request for deferral of examination under this paragraph must include the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). A request for deferral of examination under this paragraph will not be granted unless:\*\*>

(1) The application is an original utility or plant application filed under § 1.53(b) or resulting from entry of an international application into the national stage after compliance with § 1.495;<

(2) The applicant has not filed a nonpublication request under § 1.213(a), or has filed a request under § 1.213(b) to rescind a previously filed nonpublication request;

(3) The application is in condition for publication as provided in § 1.211(c); and

(4) The Office has not issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(e) *Notice of suspension on initiative of the Office.* The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

(f) *Suspension of action for public safety or defense.* The Office may suspend action by the Office by order of the Commissioner if the following conditions are met:

(1) The application is owned by the United States;

(2) Publication of the invention may be detrimental to the public safety or defense; and

(3) The appropriate department or agency requests such suspension.

¶ 7.54.02 *Request for Termination of a Suspension of Action, Granted*

Applicant's request filed on [1], for termination of a suspension of action under 37 CFR 1.103, has been approved. The suspension of action has been terminated on the date of mailing this notice.

**Examiner Note:**

In bracket 1, insert the filing date of the request for termination of the suspension of action.

**AT THE INITIATIVE OF THE OFFICE**

>Suspension of action at the initiative of the Office should be avoided, if possible, because such suspension will cause delays in examination, will increase pendency of the application, and may lead to a shortening of the effective patent term or, conversely, patent term extension, or adjustment, due to the suspension. Once a suspension of action has been initiated, it should be terminated immediately once the reason for initiating the suspension no longer exists, even if the suspension period has not expired.<

\* { 37 CFR 1.103(e) provides that the Office will notify applicant if the Office suspends action in an application on its own initiative. >Every suspension of action initiated by the Office will be limited to a time period of a maximum of 6 months.< An examiner may grant an initial suspension of Office action on his or her own initiative, as in MPEP § 709.01 and § 2315.01, for a maximum period of 6 months. \*\*>A notification of suspension must be mailed to the applicant for each Office-initiated suspension of action, even for second or subsequent suspensions, and must include a suspension period (a maximum of 6 months). When the suspension period has expired, the examiner should take up action on the application or evaluate all possibilities for giving an action on the merits. For example, if a reference is still not available after waiting for six months, the examiner should try to find another source for the information or update the search to find another reference that can be

used to make a rejection. If, in an extraordinary circumstance, a second or subsequent suspension is necessary, the examiner must obtain the TC director's approval (see MPEP § 1003) and prepare another suspension notification with a suspension period (a maximum of 6 months). The notification for a second or subsequent suspension must be signed by the TC Director.<

Suspension of action under 37 CFR 1.103(f) is decided by the TC Director of work group 3640.

The following form paragraphs should be used in actions relating to suspension of action at the initiative of the Office.

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¶ 7.52 *Suspension of Action, Awaiting New Reference*

A reference relevant to the examination of this application may soon become available. *Ex parte* prosecution is SUSPENDED FOR A PERIOD OF [1] MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

**Examiner Note:**

1. Maximum period for suspension is six months.
  2. The TC Director must approve all second or subsequent suspensions, see MPEP § 1003.
  3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.
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¶ 7.53 *Suspension of Action, Possible Interference*

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF [1] MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

**Examiner Note:**

1. Maximum period for suspension is six months.
2. The TC Director must approve all second or subsequent suspensions, see MPEP § 1003.
3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.